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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/966,613
Filing Date: September 27, 2001
Appellant(s): SAGAR, RIK

MAILED

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GROUP 3600

Terry W. Kramer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 26 February 2007 appealing from the Office action
mailed 29 September 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Sunyich, United States Publication No. 2003/0149576 A1, 19 April 2001

Daum et al., United States Publication No. 2003/0109938 A1, 18, July 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Sunyich, Pub. No. US2003/0149576 A1.

As per Claim 1, Sunyich discloses an automated booking system for guest accommodations, comprising:

- a guest accommodation which can be automatically booked by the system and used by the customer for a period of time (0016, 0017 and 0021);
- a provider network of a guest accommodations reservation provider having a data base for customer preferences (008 and 0022);
- reserving means for communication between a home network and the provider network for reserving the guest accommodations for a period of use (008 and 0022);
- preference transmission means for transmitting customer preferences from a data base of the home network to the data base of the provider network (0026 and 0027);

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- and means for accessing the provider data base for providing the accommodations depending on the customer preferences (0021).

As per Claim 2, Sunyich further discloses a system in which the guest accommodations are selected from: a hotel room with hotel facilities, a guest office with office facilities, a rental car package, an airline seat package, a restaurant table package, and a train seat package (0045, lines 14-20).

As per Claim 3, Sunyich further discloses a system in which the customer preferences include the configuration of the guest accommodations (0014, lines 1-4).

As per Claim 4, Sunyich further discloses a system in which the customer preferences include preferences regarding the location of the guest accommodations with respect to features of the accommodations or the locations of accommodations of other guests (0015, lines 1-15).

As per Claim 5, Sunyich further discloses system in which the customer preferences include user programmable settings of consumer appliances in the guest accommodations (0016 and 0017).

As per Claim 6, Sunyich further discloses a system in which the customer preferences include preferred contents of a refrigerator in the guest accommodation (0017, lines 3-5).

As per Claim 7, Sunyich further discloses a system in which the customer preferences include preferred food and food preparation equipment in the guest accommodations (0017, lines 7-11).

As per Claim 8, Sunyich further discloses a system in which the customer preferences include meal preferences (0017).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunyich, Pub. No. US2003/0149576 A1.

As per Claims 9 and 10, Sunyich fails to explicitly disclose customer preferences including preferred office equipment or supplies in the guest accommodations. However, Sunyich teaches a system in which the customer preferences include preferred environmental settings, food, lighting and internet connection (0016, 0017 and 0045). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Sunyich and include preferences for preferred office equipment because it would provide the customer with an improved user-friendly system with greater convenience.

5. Claims 11-17, and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunyich, Pub. No. US2003/0149576 A1 in view of Daum et al., Pub. No. US2003/0109938 A1.

As per Claims 11 and 25, Sunyich discloses an automated booking system for guest accommodations, comprising:

- a guest accommodation which can be automatically booked by the system and used by the customer for a period of time and which can be provided with guest appliances (0016, 0017 and 0021);
- a network of an accommodations provider, the provider network having a data base, the guest appliances of the guest accommodations are connected to the provider network (0021, see Figure 1);
- reservation means in communication with a home network of a customer and the provider network for reserving the guest accommodations for a period of use (008, 0026 and 0027);
- settings transmission means for transmitting the user programmable settings of the home appliances of the customer to the provider data base (0008); and
- means for downloading the user programmable settings from the provider data base into the guest appliances of the guest accommodations for programming the appliances of the guest accommodations at the time of the customer's use of the accommodations (0008, 0021 and 0022).

Nonetheless, Sunyich fails to disclose a system comprising a home network of a customer, the home network interconnecting home appliances having user programmable

settings. However, Daum et al. teaches a home network that transmits commands between a source and appliances (See Claim 1 of Daum et al). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Sunyich and include the preferences from the home network of the customer as taught by Daum et al. because it greatly improves the efficiency of the system by providing the user with convenience and a system that is user-friendly.

As per Claims 12, Sunyich fails to explicitly disclose a system in which settings for a plurality of the customer's home appliances are transmitted, stored and downloaded into corresponding appliances of the accommodations that have functions similar to the corresponding home appliances. However, Sunyich teaches a system that allows users to enter their preferred environmental preferences, and also discloses that the system would be appropriate in other lodging situations (0008 and 0045). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Sunyich and include the preferences from one's home network because it greatly improves the efficiency of the system by providing the user with convenience and a system that is user-friendly.

As per Claim 13, Sunyich further discloses a system in which the settings of a plurality of the customer's home appliances are analyzed to determine user programmable settings for appliances that are different from the customer's home appliances (0015, lines 11-15).

As per Claim 14-16, Sunyich fails to disclose a system in which the home network includes a data base containing the user programmable settings of devices connected to the home network. However, Daum et al. teaches a database to control the programmable settings of the home network (0034). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Sunyich and include a database with programmable settings of the appliances as taught by Daum et al. because it greatly improves the efficiency of the system by providing the user with convenience and a system that is user-friendly.

As per Claim 17, Sunyich further discloses a system in which the external network includes one or more of: a cable television network, a telephone network, and the internet (0019).

As per Claim 20, Sunyich further discloses a system in which the programmable settings include environmental settings selected from one or more of temperature, humidity, and light level settings (0016).

As per Claim 21, Sunyich further discloses a system in which the programmable settings include a channel map for translating between sources of multimedia programming and means for selecting multimedia programming (0016, lines 10-15).

As per Claim 22, Sunyich further discloses a system in which the means for selecting programming includes a plurality of buttons on a remote control and channel map allows the customer in the hotel room to use the same series of one or more remote control buttons to select a desired programming source as the series of buttons he uses in his home to select that source (0016, lines 10-15).

As per Claim 23, Sunyich further discloses a system in which the programmable settings include settings of software of a personal computer of the hotel room (0016, lines 14-15).

As per Claim 24, Sunyich further discloses a system in which the programmable settings include security settings including a security code of a room alarm system (0015, line 10).

6. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunyich, Pub. No. US2003/0149576 A1 in view of Daum et al., Pub. No. US2003/0109938 A1 as applied to claim 11 above, and further in view of Lee et al., U.S. Patent No. 4,899,373.

As per Claims 18 and 19, Sunyich fails to disclose in which the programmable settings include speed dial settings for dialing make telephone calls or a facsimile by pushing fewer buttons than the number of digits in corresponding phone numbers. However, Lee et al. teaches a database with a customer's programmed speed dials (C. 1, lines 56-59). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Sunyich and include preferences for programmable settings that include speed dialing

as taught by Daum et al. because it greatly improves the convenience of the system by providing the user with convenience and a system that is user-friendly.

(10) Response to Argument

First Issue

Regarding the Appellant's arguments that the Patent Office has fails to establish a *prima facie* case of obviousness, the Examiner asserts that the combination of references, i.e. Sunyich in view of Daum et al., is proper. In this case, one of ordinary skill in the art would have been led to combine Sunyich and Daum et al. in view of the fact that both references are directed to transmitting commands and preferences of appliances (e.g., refrigerators, air conditioners, etc) through a communication network. Further, both systems are aimed at providing users with convenience by providing a system that initiates control of appliances in a lodging environment (e.g., home, hotel, etc).

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *In re Dembiczak*, 50 USPQ2d 1614. Therefore, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. *In re Kahn* 78 USPQ2d 1329 (CAFC 2006). Thus, someone of ordinary skill in the art would be led to combine Sunyich and Daum et al.

Second Issue

Regarding the Appellant's argument that, "the declaration under 37 C.F.R. § 131 submitted in conjunction with an invention disclosure form submitted by the inventor to the patent department of Koninklijke Philips Electronic, N.V., is sufficient to establish conception at least as of April 30, 1999", is incorrect. The applicant's argument is defective for the following reasons, there is no proof of conception. In the Appellant's Declaration submitted 24 July 2006, he recites the inventor submitted written invention disclosure materials to the patent department of Koninklijke Philips Electronics, N.V., however the Appellant never submitted these invention disclosure forms, other than the invention disclosure form stating the *short title* and an *ID Date* of 30 April 1999. The mere showing of a form stating a title and an internal departmental ID date is not sufficient documentary proof of conception. Further documentary proof, for example, flow charts, diagrams or specification showing the initial stages of the invention would have been sufficient proof of conception. In view of the fact that no evidence other than a form submitted with a short title and ID date, the Appellant has not proved a conception date of 30 April 1999. "[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill." *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without "exercise of the inventive faculty." *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978). See also *Coleman v. Dimes*, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must

have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.); *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F.2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) (Conception is the “formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.”); *Hitzeman v. Rutter*, 243 F.3d 1345, 58 USPQ2d 1161 (Fed. Cir. 2001). Second, in determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958). The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Sunyich reference to either a constructive reduction to practice or an actual reduction to practice. The absence of activity between the dates of 30 April, 1999 and 27 August, 2001 do not prove that due diligence was taken toward constructive reduction to practice. The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 118 USPQ 96, 100 (CCPA 1958). While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The mere showing of an invention disclosure form submitted to the assignee’s patent department is insufficient to meet the requirements for due diligence. Although the Appellant provides an excuse for the inactivity (backlog in the

patent department of Koninklijke Philips Electronics) between the period of conception and constructive reduction to practice, the Appellant fails to provide any evidence of such.

Third Issue

Appellant argues that Sunyich does not disclose, “preference transmission means for transmitting the customer preferences from a database of the home network to the database of the provider network.” However, Examiner notes that Sunyich discloses an electronic network which is configured to prepare the hotel room as specified by the environmental preferences, where the environmental preferences are stored in a database and retrieved during check-in (0008). Also, Examiner notes that Sunyich also discloses a database storing guest preferences. Sunyich discloses a smart card (e.g. database of home network) which stores guest preferences, and can be used to electronically check-in to a hotel room in advance of arriving to the hotel or scanned when beginning the automated check-in process, therefore transmitting the guest preferences from the guest database to the provider database (0026-0027). Sunyich further discloses transmitting the customer preferences after the reservation preferences have been matched, wherein the environmental preferences are activated through an electronic network. The electronic network is configured to apply the environmental preferences that represent the alterable room options. The computer program sends messages to the electronic peripherals in the hotel room, and these messages can be sent via a physical wire network or wirelessly (0031). Sunyich goes on to disclose other physical room options may also be set when the appropriate electronic peripheral hardware is installed in the hotel room. For example, a guest can control

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the heat of the bathroom water, whether the television is on or off, what time the coffee begins brewing, a time for refrigerator unit power down, etc. (0032).

Further the Appellant argues that Sunyich fails to disclose, "setting transmission means...", however Examiner notes that Sunyich discloses allowing a user to enter their preferences using an graphical user interface or a website (0019). The Examiner noted that Sunyich failed to disclose a system comprising a home network of a customer, the home network interconnecting home appliances having user programmable settings. The Daum et al. reference was cited for teaching a home network which transmitted commands between a source and appliances. Daum et al. teaches the ability to save user configurable settings for appliances (Claim 1 of Daum et al., also see Figure 5). Therefore, the combination of Sunyich and Daum et al. teach a network containing user appliance settings that are transmitted from a home network to a provider network.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Fadey S. Jabr
Examiner
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Conferees:

Igor Borissov

Vincent Millin

John Hayes

JOHN W. HAYES

SUPERVISORY PATENT EXAMINER